UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,053	06/28/2000	Eric Lauzon	584-1027	5671

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EXAMINER
HARTMAN JR, RONALD D

ART UNIT	PAPER NUMBER
2121	

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. ,
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2003* .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

    4a) Of the above claim(s) *12,13 and 15-24* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)   4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4,6,7* .   6) ☐ Other: .

DETAILED ACTION

1.   Due to the changes implemented with respect to claim dependencies via the Amendment, claims 13, 15 and 17-22 now all depend from claim 12 (Group II). Therefore, since Group II was not chosen with respect to the election requirement, these claims, 12-13, 15 and 17-22 will not be treated on their merits. Furthermore, claims 16 and 23-24 will not be treated because of their non-election as well.

2.   Claims 1-11 and 14 are now presented for examination purposes and an action appears below on their merits.

Abstract

3.   The abstract is objected to because it is too long. The abstract should be confined to 150 words or less.

Claim Objections

4.   Claim 2 is objected to because of the following informalities: There is no period at the end of the claim. Appropriate correction is required.

Claim 14 is objected to because of the use of the word "such". Since the use of this word is sometimes deemed to be indefinite, the applicant is advised to change the wording to "said processor is arranged to execute the accessed software code so that the destination terminal is controlled".

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims 3-4, 8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

Claim 3 recites the limitations "the identity" and "the caller" in line 2. There is

insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitations "the accessed configuration information" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitations "the called party" in line 3. There is insufficient

antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the
> United States before the invention thereof by the applicant for patent, or on an international application
> by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
> title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) do not apply to the examination of this application as the application

being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

published under 35 U.S.C. 122(b). Therefore, this application is examined under 35

U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7.   Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Arnold et al.,

U.S. Patent No. 6,446,070.

As per claim 1, Arnold teaches a method of communicating between a first node

and a second node in a communications network, comprising the steps of:

-       associating computer software with a message (Figure 3, Remote

Compute Call 306; col. 6, lines 4-31);

-       sending the message from the first client associated with the first node to

the second client associated with the second node (server)(Col. 6, lines 4-31; Fig 3,

client 302, server 316); and

-       executing the computer software using the second node (Col 6 lines 23-

41).

8.   Claims 1, 3-4, 10 and 14 are also rejected under 35 U.S.C. 102(e) as being

unpatentable over Giordano, III et al., U.S. Patent No. 6,285,364 (hereafter: Gio) having

an effective filing date of 6/3/1997.

Claims 1 and 14 set forth, in light of the specification page 8 lines 14-25, a

method comprising:

-       a caller initiating a call;

-       caller identity data being sent to a phone; and

-        displaying the callers identity using a processor of the phone.

These claims, in essence, are claiming an Internet capable phone system that allows callers identities to be viewed at the called party's phone. In other words, a system that is comprised of a computer that receives a phone call, via the Internet, from another computer, wherein the called computer displays the identification of the caller. This system is taught by Gio (Figure 3).

9.   As per claim 3, Gio teaches an address book (Fig 3 element 56).

10.   As per claim 4, Gio teaches the identity of the caller being displayed (Fig 3, 44).

11.   As per claim 10, Gio teaches a feature for forwarding a call to voice mail (Fig 3 element 50).

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 2, 5-9 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano, as applied to claim 1 above.

13.   As per claims 2, 5 and 14, Official Notice is taken with respect to "call blocking"

and "priority levels" of incoming calls as they are features that are well known in the art

of telephonic communications and would have been an obvious addition to A since they

would afford the called party greater control over incoming calls. Graphical user

interfaces for internet phones were very well known at the time the invention was made,

and since the aim of A is to control the destination terminal by indicating the identity of

the caller, and since "call blocking" and "priority levels" are features that were well

known in the art at the time the invention was made, their incorporation would have

been obvious to one of ordinary skill in the art at the time the invention was made since

they would form a more effective way of dealing with incoming calls, that is, by allowing

the computer phone to ignore numbers or persons that are not wanted or by placing

them in an order of relevance to the caller.

14.   As per claims 6 and 8, the recognition of an "off the hook" condition and the

clearing of the destination terminal are both obvious variations of the disclosed system

since they are both features that were well known at the time the invention was made. A

busy signal is a well-known feature of telephone systems, and its applicability in Internet

phone applications is equally well known. Resetting or clearing the computer phone

before accepting a new call would form a more effective way of eliminating dropped

calls since it would allow for an incoming buffer to be empty so that no possible overflow

condition or other potentially disruptive behavior is observed while using the Internet

phone.

15.   As per claims 7 and 9, the use of configuration information about the called

phone is not disclosed by A but would have been obvious at the time the invention was

made since it would allow for the previously described "call blocking" feature to be

implemented, this feature have already been given Official Notice (see rejection of

claims 2 and 5). That is, a feature to allow for the caller's phone to determine if the

called phone is available, since, if the called phone is off the hook, the called phone

cannot accept the call and therefore since the phone being off the hook would cause a

busy signal, the busy signal and its inherent representation of the called phones

configuration is viewed to adequately teach or at least adequately suggest the claim

limitations of the instant claim.

16.   Claim 11 is rejected as being unpatentable over Arnold, as applied to claim 1

above, and further in view of Handley et al. (RFC 2543 – SIP: Session Initiation

Protocol).

        As per claim 11, Arnold teaches JAVA (Col 3, lines 47-51) but does not teach the

use of SIP.

        Handley teaches nodes comprising an SIP client (page 9, lines 17-19; page 11,

lines 4-7).

        It would have been obvious at the time the invention was made to have modified

Arnold by employing SIP clients and servers, as well as associating SIP messages with

computer software in order to utilize the software in conjunction with the multimedia

session conducted between the client and the server.

Conclusion

17.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald D. Hartman Jr. whose telephone number is (703) 308-7001. The examiner can normally be reached Monday-Friday, 11:30 am – 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached at (703) 305-8498. The fax number for this examiner is (703) 746-5408.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9618.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 746-7239, (for formal communications intended for entry)

Or:

(703) 746-7240, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Ronald D. Hartman Jr.
Patent Examiner
Art Unit 2121
June 1, 2003

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